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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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| Proceeding | 91221590 |
| Party | Defendant S.C. ION MOS S.R.L. |
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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| EMERSON ELECTRIC CO., |) | |
| |) | |
| Opposer, |) | |
| |) | Opposition No. 91221590 |
| v. |) | Application No. 79138965 |
| |) | Mark: EMERSON TECHNIK & DESIGN |
| S.C. ION MOS S.R.L., |) | |
| |) | |
| Applicant. |) | |
| | / | |

**APPLICANT’S MOTION TO DISMISS COUNT II OF OPPOSER’S FIRST AMENDED
NOTICE OF OPPOSITION FOR FAILURE TO STATE A CLAIM PURSUANT TO FED. R.
CIV. P. 12(B)(6) AND TBMP §503, AND MOTION FOR SUSPENSION OF PROCEEDING**

Pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure and TBMP §503, Applicant S.C. Ion Mos S.R.L., through its undersigned counsel, hereby moves to dismiss Count II of *Opposer’s First Amended Notice of Opposition* on the ground Opposer has failed to state a claim upon which relief can be granted. Opposer also moves the Board to suspend the instant proceedings pending the outcome of this potentially dispositive motion.

INTRODUCTION

On April 21, 2015, the instant proceeding was instituted. On May 30, 2015, Applicant filed a consented motion to extend the deadline to answer the opposition to June 30, 2015. On June 30, 2015, Applicant moved to dismiss Counts II and III of the Notice of Opposition, on the ground that such counts failed to state claims upon which relief can be granted. On July 21, 2015, Opposer filed *Opposer’s First Amended Notice of Opposition*, deleting Count III (that the mark of Application No. 79138965 is likely to falsely suggest a connection pursuant to §2(a) of the Trademark Act) and revising its Count II (that the mark of Application No. 79138965 is deceptive pursuant to §2(a) of the Trademark Act). Applicant acknowledges that Count III has been deleted, and that the *Opposer’s First Amended Notice of Opposition* is now the operative pleading in this proceeding.

Applicant hereby moves to dismiss amended Count II of *Opposer's First Amended Notice of Opposition* on the basis that Opposer has failed to state a claim upon which relief could be granted.

ARGUMENT

I. LEGAL STANDARD FOR A MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM PURSUANT TO FED. R. CIV. P. 12(B)(6) AND TBMP §503.

Under Fed. R. Civ. P. 12(b)(6), the Board must dismiss a claim that is not “plausible on its face.” TBMP §503.02, citing *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007). A motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiency of a pleading. TBMP §503.02. The Board reviews a motion to dismiss by assuming all well-pleaded allegations are true, and construing these allegations in a light most favorable to the opposer. *Consol. Foods Corp. v. Big Red, Inc.*, 226 U.S.P.Q. 829, 831 (TTAB 1985). To survive a motion to dismiss, Opposer must show that a valid ground exists for denying the registration sought. TBMP §503.02.

II. THE BOARD SHOULD DISMISS COUNT II BECAUSE OPPOSER DID NOT PLEAD THE ESSENTIAL ELEMENTS OF A § 2(A) DECEPTIVENESS CLAIM.

As will be shown, Opposer's amended Count II for deceptiveness is still nothing more than a Section 2(d) likelihood of confusion claim dressed up as a Section 2(a) deceptiveness claim.

Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a), states, in relevant part:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(a) Consists of or comprises immoral, deceptive, or scandalous matter...

The Court of Appeals for the Federal Circuit has articulated the following test for whether a mark consists of or comprises deceptive matter:

1. Is the term misdescriptive of the character, quality, function, composition or use of the goods?
2. If so, are prospective purchasers likely to believe that the description actually describes the goods?
3. If so, is the misdescription likely to affect a significant portion of the relevant consumers' decision to purchase?

In re Budge Mfg. Co. Inc., 8 U.S.P.Q.2d 1259, 1260 (Fed. Cir. 1988), *aff'g.*, 8 U.S.P.Q.2d 1790 (TTAB 1987). See also TMEP §1203.02(b).

The Board has long recognized the distinct elements and purposes of Section 2(d) versus Section 2(a) deceptiveness claims. As the Board stated in *Miller Brewing Co. v. Anheuser-Busch, Inc.*, 27 U.S.P.Q. 2d 1711, 1712 (TTAB 1993):

A proper pleading of "deceptiveness" under Section 2(a) requires the plaintiff to do more than parrot the language of Section 2(d). The latter provision of the Trademark Act prohibits registration of marks which are likely to deceive a consumer as to the source or origin of goods or services. By contrast, Section 2(a) of the Act prohibits registration of marks which lead a consumer to draw a false conclusion about the nature or quality of goods or services under circumstances where such a conclusion will be material to the consumer's deliberations regarding purchase of the goods or services. See, e.g. *Consorzio del Prosciutto di Parma v. Parma Sausage Products Inc.*, 23 USPQ2d 1894 (TTAB 1992) (issue was whether use of PARMA for meat products not made in Parma, Italy deceived consumers in regard to geographic origin of goods); *U.S. West Inc. v. Bell South Corp.*, 18 USPQ2d 1307 (TTAB 1990) (issue was whether use of THE REAL YELLOW PAGES for telephone directories deceived consumers by suggesting that competitive directories were somehow invalid, inaccurate or incomplete); *American Speech-Language-Hearing Association v. National Hearing Aid Society*, 224 USPQ 798 (TTAB 1984) (issue was whether use of phrase CERTIFIED HEARING AID AUDIOLOGIST as part of a collective membership mark deceived consumers into believing that hearing aid dealers possessed training and education of audiologists); and *Tanners' Council of America, Inc. v. Samsonite Corporation*, 204 USPQ 150 (TTAB 1979) (issue was whether use of SOFTHIDE for imitation leather material deceived consumers by leading them to conclude goods were made of real leather).

When a plaintiff's allegation is that consumers are "deceived into" buying defendant's goods under the mistaken belief that they originate from the same source as plaintiff's, or vice versa, the sort of deception at issue is the basis for a Section 2(d), not a Section 2(a), claim. (Emphasis added.)

See also, J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §11:58 (4th ed. 2011); *Springs Indus., Inc. v. Bumblebee Di Stefano Ottina et.al*, 222 U.S.P.Q. 512, 515 (dismissing Section 2(a) claim based on alleged source of origin deceptiveness because such deception "is the basis for a Section 2(d), but not a Section 2(a) ... claim").

Count I of *Opposer's First Amended Notice of Opposition*, alleges that Applicant's Mark is likely to be confused with Opposer's EMERSON formative marks, a claim made under Section 2(d) of the Trademark Act. Section 2(d) states, in relevant part, as follows:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be **likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive ...**

15 U.S.C. §1052(d) (emphasis added).

In amended Count II of *Opposer's First Amended Notice of Opposition*, Opposer alleged:

14. Applicant's "EMERSON TECHNIK" Mark is likely to deceive consumers into believing that Applicant's Goods have been developed and manufactured consistent with the highly respected technology and "techniques" employed by Emerson in the manufacturing of its machinery and various machinery parts used in, but not limited to, the food industry.

15. Were Applicant to produce, market, and distribute Applicant's Goods under the challenged EMERSON TECHNIK mark, those products would be promoted and marketed to Emerson's customers for, and would be distributed in the same and/or similar channels of trade as, many of the EMERSON Goods offered under the EMERSON Marks. Accordingly, persons familiar with Opposer's EMERSON Marks are likely to be deceived into purchasing and using Applicant's Goods offered under Applicant's Mark in the mistaken belief that those goods were produced under Emerson's manufacturing techniques and emanate from, or are authorized, sponsored and/or endorsed by, Emerson within the meaning of Section 2(a) of the Trademark Act, 15 U.S.C. 1052(a).

16. Emerson has been in existence since at least as early as September 24, 1890.

17. Applicant's Mark falsely suggests a connection between Applicant's Goods and Emerson. EMERSON was and is a well-known name for Opposer of sufficient fame or reputation such that with any use of Applicant's EMERSON TECHNIK mark for Applicant's Goods, a connection with Emerson would be assumed, resulting in injury to Opposer.

Paragraph 14 alleges that consumers would understand "EMERSON TECHNIK" to refer to Opposer. Paragraph 15 further states that "persons familiar with Opposer's EMERSON Marks are likely to be deceived into purchasing and using Applicant's Goods offered under Applicant's Mark in the mistaken belief that those goods were produced under Emerson's manufacturing techniques and emanate from, or are authorized, sponsored and/or endorsed by, Emerson." This section also references the overlapping target consumers and channels of trade. Further, Paragraph 17 asserts that the EMERSON

TECHNIK & DESIGN mark would falsely suggestion a connection between Applicant's goods and Opposer. These are likelihood of confusion allegations.

Deceptiveness under Section 2(a) does not relate to confusion as to source. It relates to a mark being misleading as to the "character, quality, function, composition or use of the goods." Standing to bring this claim is not predicated on an opposer's or petitioner's prior trademark rights and potential damage to those rights. As the Board stated in *Corporacion Habanos SA v. Rodriguez*, 99 U.S.P.Q.2d 1873, 1876 (TTAB 2011):

[W]here, as here, the pleaded ground is that the mark sought to be cancelled is deceptive under Section 2(a), or primarily geographically deceptively misdescriptive under Section 2(e)(3), petitioners do not need to own a pending application for the mark, do not have to be using the term as a mark, or even use the term at all, in order to establish their standing.

The allegations of amended Count II of *Opposer's First Amended Notice of Opposition* are likelihood of confusion allegations, predicated on claimed prior rights in "EMERSON" and Opposer's "techniques." Opposer alleges that the misdescription in Applicant's mark is that that "EMERSON TECHNIK" will cause consumers to believe that the mark is a reference to Opposer and its "techniques." This is not an allegation that "EMERSON TECHNIK" misdescribes the "character, quality, function, composition or use of the goods" to consumers. The damage Opposer alleges is that the mark is likely to cause a false suggestion of a connection with Opposer. This is a likelihood of confusion claim, couched in deceptiveness verbiage. As the Board stated in *Miller Brewing*, "[w]hen a plaintiff's allegation is that consumers are 'deceived into' buying defendant's goods under the mistaken belief that they originate from the same source as plaintiff's, or vice versa, the sort of deception at issue is the basis for a Section 2(d), not a Section 2(a), claim." *Id.* at 1712.

None of the allegations in the Amended Notice of Opposition addresses the elements required for a finding that Applicant's mark is deceptive under Section 2(a). As such, Opposer has not properly pled a claim of deceptiveness pursuant to Section 2(a) of the Trademark Act, and Count II of *Opposer's First Amended Notice of Opposition* should be dismissed on such basis.

III. REQUEST FOR SUSPENSION OF PROCEEDINGS

Pursuant to TBMP §510.03(a), the filing of a dispositive motion such as a motion to dismiss will suspend the case “with respect to all matters not germane to the motion.” *See also* 37 C.F.R. §2.127(d); *DAK Industries Inc. v. Daiichi Kosho Co.*, 35 U.S.P.Q.2d 1434 (TTAB 1995) (suspending proceeding pending disposition of motion for judgment on the pleadings); *SDT Inc. v. Patterson Dental Co.*, 30 U.S.P.Q.2d 1707 (TTAB 1994) (stating the Board “will always suspend a case in which a potentially dispositive motion has been filed”); *Consol. Foods Corp. v. Big Red, Inc.*, 226 U.S.P.Q. at 830 (TTAB 1985) (suspending proceeding when applicant filed, among other motions, a motion to dismiss pursuant to Fed. R. Civ.P. 12(b)(6)).

Suspension of a case upon the filing of a dispositive motion is not automatic; however, when issuing a suspension order “the Board ordinarily treats the proceeding as if it had been suspended as of the filing date of the potentially dispositive motion.” TBMP §510.03(a). Any paper filed during the pendency of a dispositive motion which is not relevant thereto will be given no consideration. Trademark Rule 2.127(d).

Applicant respectfully requests that the Board grant *Applicant’s Motion to Dismiss Count II of Opposer’s First Amended Notice of Opposition for Failure to State a Claim pursuant to Fed. R. Civ. P. 12(b)(6) and TBMP §503, and Motion for Suspension of Proceeding* with prejudice, and suspend the instant opposition pending a decision on this motion.

Respectfully submitted,

Date August 3, 2015

s/Michelle L. Visser
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CERTIFICATE OF SERVICE

I hereby certify that I served the foregoing *Applicant's Motion to Dismiss Count II of Opposer's First Amended Notice of Opposition for Failure to State a Claim pursuant to Fed. R. Civ. P. 12(b)(6) and TBMP §503, and Motion for Suspension of Proceeding* by causing a true and correct copy thereof to be sent via first class mail, postage prepaid to:

Lisabeth H. Coakley
Harness, Dickey & Pierce, P.L.C
5445 Corporate Dr, Suite 200
Troy, MI 48098

Date: August 3, 2015

s/Michelle L. Visser
Michelle L. Visser